

REMARKS

Reconsideration of the application is requested.

Claims 1-26 and 28-30 remain in the application. Claims 1-26 and 28-30 are subject to examination. Claims 5, 19, 23 and 25 have been amended. Claims 27, 31 and 32 have been canceled to facilitate prosecution of the instant application.

In item 1 on page 2 of the above-identified Office Action, the Examiner objected to the drawings for failing to show a fabric layer defining an interior side as recited in claim 31 and the imprinted fabric as recited in claim 32. Claims 31 and 32 have been canceled.

In item 3 on pages 3-5 of the above-identified Office Action, claims 1-6, 20, 21, 23, 24, 25, 29 and 30 have been rejected as being obvious over U.S. patent No. D455,479 S to Asack et al. (hereinafter Asack) in view of U.S. patent No. 2,319,603 to Henry (hereinafter Henry) under 35 U.S.C. § 103.

As the Examiner states, Asack teaches a disposable tub liner having an exterior side, an interior side, a bottom, and sidewalls. As Asack is a design patent, one can only determine the dimensions of the device from those shown in the drawings. The sidewalls of the liner shown in Asack must be rather high as to follow the side contour of the bath tub and

when viewed in relation to the width of the liner shown. It is noted that Asack teaches a tub liner and therefore its functionality must be to line a tub and have a reasonable width to cover the bottom.

The Examiner states that Asack does not specifically disclose that the sidewalls of the liner are less than 2 inches high as recited in the independent claims 1, 24 and 25 of the instant application. The Examiner further states that it would be obvious to one of ordinary skill in the art at the time to employ such dimensions. Applicant respectfully and strongly disagrees. As noted in MPEP 2143.01, the "fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness". It must pass the test that the "proposed modification cannot change the principle operation of a reference" or "the proposed modification cannot render the prior art unsatisfactory for its intended purpose".

The combination recited by the Examiner would not result in a tub liner. Clearly, the invention of Asack is a tub liner. Without sidewalls or extremely small sidewalls, the Asack taught invention would not function as a tub liner as it cannot line the tub. Therefore, the combination recited by the Examiner would fail to be capable of carrying out its primary function.

Claim 25 of the instant application has been amended to further distinguish the instant application. Claim 25 has been amended to recite that the liner has no sidewalls and is only formed of the bottom region. Support for this change is found on page 16, lines 1-8 of the specification of the instant application.

The invention in Henry relates to a protective covering for temporary use in connection with bathtubs. The purpose of the cover is to prevent marring or staining of the finished tub such as frequently occurs during construction through the dropping of plaster, lime, paint, etc. The main covering element 7 is formed of paper and has adhesive strips extending beyond the covering element 7 for attaching to the floor or rim of the tub. The inventive feature of Henry resides in its end covering elements 12 and 13 and how they are formed for wrapping around the side of the bathtub.

First, Henry is not believed to be an analogous art as it relates to the field of construction and protection of facilities under construction. In contrast, the invention of the instant application relates to the field of disposable, flexible, transportable bath liners having an entertainment factor. Second, the element 7 in Henry is made of paper which

is unsuitable for the purposes of either the instant application or Asack.

It is noted that claim 5 of the instant application has been amended to recite a single adhesive patch covering the whole bottom of the liner. Support for this feature is found on page 13, lines 13-16 of the instant application.

In regards to claim 23, the Examiner states that it is well within the general skill of a worker in the art to select a preferred enjoyable scent on the basis of suitability for it intended used as a matter of obvious design choice. Applicant respectfully disagrees and notes that claim 23 recites that the "liner is coated" with a soap, scent, bubble bath, bath oil, body lotion, moisturizer or color dye. The choice of coating the liner with one of the above items is not believed to be a mere design choice as the manner of delivery is believed to be unique in the field. In addition, providing such items adds to the appeal of the item in commercial sales and also adds an "entertainment factor". In other words, applicant respectfully challenges the Examiner to find a liner ensemble with such a coated feature. It is noted that U.S. patent publication disclosure No. 2003/0024039 to Kindley teaches a topcoat, being an acrylic coating. An acrylic coating does not read on the features of claim 23 of the instant application. Furthermore, claim 23 of the instant

application has been amended to recite the inherent feature that the coating is water activated in order to further distinguish from the prior art. Support for this change found on page 5, lines 16-19 of the instant application.

In item 4 on pages 6-9 of the above-identified Office Action, claims 7-10, 16-18, 19, 26, 28, 31 and 32 have been rejected as being obvious over U.S. patent No. D455,479 S to Asack et al. (hereinafter Asack) in view of U.S. patent No. 3,133,292 to Spier (hereinafter Spier) under 35 U.S.C. § 103.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the

problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an Examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the Examiner's comments, it is respectfully believed that the evidence adduced by the Examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. More specifically, there are no teachings, hints or suggestions in Asack for making any of the combinations recited by the Examiner because Asack is a design patent. It is respectfully stated that all of the Examiner's statements are believed to be conclusory. Accordingly, the Examiner is respectfully requested to withdraw the rejection.

In addition, claim 19 of the instant application has been amended to recite that the materials used in the liner a flexible to allow the liner to be folded, rolled up and/or

compactly stored. Support for the change to claim 19 is found on page 6, lines 15-18 and on page 15, lines 17-19.

In item 5 on pages 9-10 of the above-identified Office Action, claims 11-13 and 22 have been rejected as being obvious over Asack in view of U.S. Patent No. 5,465,436 to Bleicher (hereinafter Bleicher) under 35 U.S.C. § 103.

As claims 11-13 and 22 ultimately depend on claim 1, claims 11-13 and 22 are also believed to be allowable based on claim 1.

In item 6 on page 10 of the above-identified Office Action, claims 14 and 15 have been rejected as being obvious over Asack in view of U.S. Patent No. 4,047,259 to Lotis (hereinafter Lotis) under 35 U.S.C. § 103.

As claims 14 and 15 ultimately depend on claim 1, claims 14 and 15 are also believed to be allowable based on claim 1.

It is further noted that claim 15 of the instant application recites that the dispenser already contains a built-in soap, scent, etc. which is believed to provide an advantage as these items do not have to be individually provided.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1, 24, 25. Claims 1, 24, 25 are, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1 or 25.

In view of the foregoing, reconsideration and allowance of claims 1-26 and 28-30 are solicited.

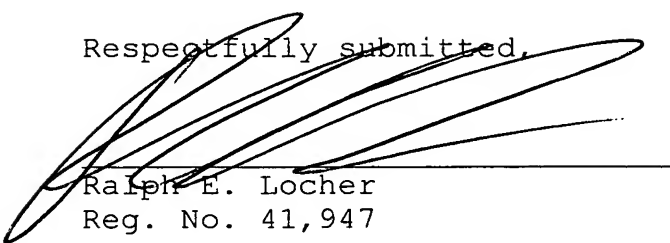
Petition for extension is herewith made. The extension fee for response within a period of one month pursuant to Section 1.136(a) in the amount of \$60.00 in accordance with Section 1.17 is enclosed herewith.

If an extension of time is required, petition for extension is herewith made. Any extension fee associated therewith should be charged to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and

Greenberg, P.A., No. 12-1099.

Respectfully submitted,



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REL:cgm

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